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CERMACK NAKAJIMA LLP 127 S. Peyton Street, Suite 210 ALEXANDRIA, VA 22314			PREBILIC, PAUL B	
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TIMOTHY P. MURPHY

Appeal 2009-014785
Application 10/770,403
Technology Center 3700

Before FRANCISCO C. PRATS, MELANIE L. McCOLLUM, and
STEPHEN WALSH, *Administrative Patent Judges*.

WALSH, *Administrative Patent Judge*.

DECISION ON APPEAL¹

This is an appeal under 35 U.S.C. § 134(a) involving claims to a method of treating morbid obesity. The Patent Examiner rejected the claims on the grounds of anticipation and obviousness. We have jurisdiction under

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

35 U.S.C. § 6(b). We reverse.

STATEMENT OF THE CASE

Claims 1, 3-6, 8-14, and 23-25, which are all the pending claims, are on appeal. Claims 1 and 23-25 are representative and read as follows:

1. A method of treating morbid obesity in a patient comprising: reducing gastric blood flow, duodenal blood flow, mesenteric blood flow, jejunal blood flow, ileal blood flow, or combinations thereof, in the patient, including placing a blood flow reducing device inside an artery that carries blood to the small intestine.
23. A method of treating morbid obesity in a patient comprising: permanently reducing gastric blood flow, duodenal blood flow, mesenteric blood flow, jejunal blood flow, ileal blood flow, or combinations thereof, in the patient.
24. A method of treating morbid obesity in a patient comprising: reducing gastric blood flow, duodenal blood flow, mesenteric blood flow, jejunal blood flow, ileal blood flow, or combinations thereof, a fixed, invariable amount in the patient.
25. A method of treating morbid obesity in a patient comprising: continuously reducing gastric blood flow, duodenal blood flow, mesenteric blood flow, jejunal blood flow, ileal blood flow, or combinations thereof, in the patient for a time effective to reduce the patient's weight.

The Examiner rejected the claims as follows:

- claims 23-25 under 35 U.S.C. § 102(b) as anticipated by Flesler;²
- claims 23-25 under 35 U.S.C. § 103(a) as unpatentable over Flesler and Ruiz;³

² Melina Flesler et al., Publication No. US 2002/0161414 A1, published Oct. 31, 2002.

³ Carlos E. Ruiz, US Patent No. 6,120,534, issued Sept. 19, 2000.

- claims 1, 3-6, 8-10 and 12-14 under 35 U.S.C. § 103(a) as unpatentable over Flesler and Ruiz; and
- claim 11 under 35 U.S.C. § 103(a) as unpatentable over Flesler, Ruiz, and Yurek.⁴

ANTICIPATION

The Issues

The Examiner's position is that Flesler taught electrical stimulation to constrict the arteries leading to the small intestine, thereby anticipating the methods defined in claims 23-25. (Ans. 5.) According to the Examiner, Flesler's reduction in blood flow "is considered to be permanent, fixed, invariable, and continuous to the extent required because these terms are terms of relative degree. The Flesler device can [be] and is used [in a] permanent, fixed, invariable, and continuous way at least for a period of time." (*Id.*)

Appellant contends "[t]here is nothing relative about any of the accused terms." (App. Br. 24.) We agree with Appellant. We also agree that the evidence supports Appellant's argument that Flesler taught temporary, not permanent, constriction of the arteries delivering blood to the small intestine. (*Id.*) We therefore reverse the rejection of claim 23, which defines a method of "permanently reducing" blood flow.

Claim 24 defines a method comprising reducing blood flow by "a fixed, invariable amount in the patient." Appellant contends: "Flesler describes intermittently electrically stimulating the tissues around the outside of a blood vessel to cause it to temporarily constrict, thus variably

⁴ Matthew T. Yurek et al., US Patent No. 5,690,644, issued Nov. 25, 1997.

reducing the blood flow through that blood vessel. There is nothing whatsoever that is fixed or invariable about the blood flow reduction that *Flesler* proposes: it is entirely variable, as *Flesler* wants it to be.” (App. Br. 28.) In our review of *Flesler*, we find no evidence that *Flesler* described reducing blood flow by a fixed, invariable amount. We therefore reverse the rejection of claim 24.

We also reverse the rejection of claim 25, which defines a method of “continuously reducing” blood flow “for a time effective to reduce the patient’s weight,” because the evidence does not support finding that *Flesler* taught continuously maintaining blood flow reduction until the patient’s weight is reduced. (See App. Br. 31.)

OBVIOUSNESS

The Issues

Flesler’s patent is entitled “Acute And Chronic Electrical Signal Therapy For Obesity.” The Examiner’s position is that *Flesler* disclosed constricting the arteries leading to the small intestine with electrical stimulation, but did not disclose placing a blood flow reducing device or an endograft inside arteries. (Ans. 3.) The Examiner found that *Ruiz* taught it was known to use physical restriction devices in arteries where needed, and concluded it would have been obvious to use *Ruiz*’s endograft device in conjunction with or in place of *Flesler*’s electrical device. (*Id.* at 3-4.)

Appellant contends:

one of ordinary skill in the art, upon a full and fair reading of *Flesler* and *Ruiz*, would not be motivated to replace *Flesler*’s external (to the artery) and intermittent blood flow reduction methodology with an internal (to the artery), permanent blood flow restrictor, such as generally disclosed in *Ruiz*. *Flesler*, as discussed above, is singularly interested in only discontinuously and intermittently restricting the

blood flow to the small intestine, timed to correspond to the presence of food in the small intestine; this is why *Flesler* suggests the placement of sensors in the body to detect food, and/or to configure the logic of the apparatus to permit its activation in synch with a meal. *Flesler* is also only concerned with modifying the blood flow to the small intestine by external stimulation of the artery that supplies blood to the small intestine, and not to an internal (to the artery) modification. Nowhere does *Ruiz* disclose or suggest that his stent should be used to treat obesity in a patient. *Yurek*'s disclosure adds nothing to this analysis.

(App. Br. 21.)

The issue with respect to this rejection is whether the rejection provided a reasoned explanation that supports its proposed modification of *Flesler*'s method.

Principles of Law

An invention

composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art [I]t can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does.

KSR Int'l Co. v. Teleflex Inc., 550 U.S. 398, 418 (2007). Thus, “[r]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006).

Analysis

We are persuaded by Appellant's argument that the rejection did not provide a satisfactory explanation for either supplementing *Flesler*'s method

with Ruiz's endograft or replacing Flesler's method with Ruiz's endograft. The preponderance of the evidence supports Appellant's contention that Flesler taught using electrical stimulation during or after meals, not continuously or permanently, and not by a method that necessarily reduced blood flow by a fixed, invariable amount. The rejection did not account for that difference by explaining why one of skill in the art would have thought it desirable to shift from temporary to permanent blood flow restriction. We therefore reverse the obviousness rejections of claims 1, 3-6, 8-10, 12-14 and 23-25.

SUMMARY

We reverse the rejection of claims 23-25 under 35 U.S.C. § 102(b) as anticipated by Flesler.

We reverse the rejections of claims 1, 3-6, 8-10, 12-14 and 23-25 under 35 U.S.C. § 103(a) as unpatentable over Flesler and Ruiz.

REVERSED

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